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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,838	08/12/1998	OLEG LLIICH EPHSTEIN		4128

7590 07/13/2004  
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EXAMINER

OWENS JR, HOWARD V

ART UNIT	PAPER NUMBER
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1623

26

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/117,838

**Applicant(s)**

EPHSTEIN, OLEG LLIICH

**Examiner**

Howard V Owens

**Art Unit**

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

#### **35 U.S.C. 112(2)**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 24, the use of the term “information” is unclear. The scope of the claim suggests that the “information” is a part of the medicinal substance; however it is unclear what exactly constitutes the “information”.

In claim 28, the statement “a homeopathic method is simultaneously into an organism” is unclear because there is no route of administration or vehicle in the claim which coincides with the term simultaneously.

#### **Claim Rejections - 35 USC § 102**

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 – 28 and 36-38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Amitai et al., EP 0687 466.

Claims 17 – 28 are drawn to a method of making a medication comprising the steps of making from an initial material an active medicinal substance in a therapeutic dose via homeopathic method.

Claim 36 is drawn to simultaneously introducing the active ingredient and a potentiated form of the active ingredient into an organism.

Claim 38 is drawn to separately introducing the active ingredient and a potentiated form of the active ingredient into an organism.

Amitai et al. anticipates the claims cited supra as it teaches the method of making a making a (columns 2-4, claims 1-3 and 7) medication via homeopathic preparation wherein an active ingredient is diluted (potentiated) with an inert carrier for administration into the human body.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 17-38 are rejected under 35 U.S.C. § 103 as being unpatentable over Amitai et al., EP 0687 466.

Claims 17 – 28 are drawn to a method of making a medication comprising the steps of making from an initial material an active medicinal substance in a therapeutic dose via homeopathic method. Dependent claims 29- 35 are drawn to the use of potentiated doses of known compounds.

Claims 36 and 37 are drawn to simultaneously introducing the active ingredient and a potentiated form of the active ingredient into an organism.

Claim 38 is drawn to separately introducing the active ingredient and a potentiated form of the active ingredient into an organism.

Amitai et al. anticipates the claims cited supra as it teaches the method of making a making a (column 1, lines 5-27; columns 2-4; claims 1-3 and 7) medication via homeopathic preparation wherein an active or ingredient or medicament is diluted (potentiated) with an inert carrier for administration into the human body.


Amitai teaches the potentiation of any medicament and does not cite the specific compounds as claimed in claims 29-35; however, the test of the patentability of a method directed to a new use of an old compound is the unobviousness of that new use. If the result of the process is unobvious and the particular use of the material is not suggested by the prior art, the process is patentable. As such, applicant's potentiation of known compounds using the established method of homeopathic preparation as recognized by Amitai does not impart a new use nor result suggested by the prior art.

It would have been *prima facie* obvious for one of skill in the art to make a medication using potentiation or dilution of an active substance.

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One of skill in the art would have been motivated to potentiate an active medicinal substance as this method has been taught in the prior art practice of homeopathic preparation for introduction of lower doses of pharmacological agents.

Howard V. Owens  
Patent Examiner  
Art Unit 1623



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Samuel Barts  
Primary Patent Examiner  
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.